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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,639	01/04/2002	Ronald J. Scherer	3616.213US01	9187

23552 7590 10/08/2003

MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS, MN 55402-0903

EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
----------	--------------

1722

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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*omitted  
action many*

# Office Action Summary

Application No.

10/038,639

Applicant(s)

SCHERER ET AL.

Examiner

Donald Heckenberg

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 and 45-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-41, 43 and 44 is/are rejected.
- 7) ☒ Claim(s) 42 is/are objected to.
- 8) ☒ Claim(s) 1-61 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 4, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

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1. The previous restriction requirement has been withdrawn, and a new restriction requirement has been set forth as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 3, 5, 7-8, 10-15, 17-18, 20-23, and 60-61, drawn to a process for producing a masonry block, classified in class 264, subclass 69.

II. Claims 24-44, drawn to a mold assembly for forming a masonry classified, classified in class 425, subclass 263.

III. Claims 2, 4, 6, 9, 16, 19, and 45-59, drawn to a masonry block, classified in class 52, subclass 608.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as

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claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed could be made by another and materially different process such as a process which uses a mold in which the sides of the mold are attached by a hinge to a mold bottom, as opposed to using open bottom mold and pallet. In such a process, the product would be removed from the mold by swinging the sides away from the mold as opposed through the reopened bottom.

Note, claims 2, 4, 6, 9, 16, and 19 are product-by-process claims. The determination of patentability in product by process claims is based on the product itself. The patentability of a product does not depend on its method of production. In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Brown, 459 F.2d 531, 173 USPQ 685 (Cust. & Pat. App. 1972); In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (Cust. & Pat. App. 1969).

3. Inventions Group II and Group III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for

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making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed could be made by another and materially different apparatus such as a molding apparatus in which the sides of the mold are attached by a hinge to the bottom of the mold as opposed to using open bottom mold and pallet. In such an apparatus, the product would be removed from the mold by swinging the sides away from the mold as opposed through the reopened bottom.

4. Inventions Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus could be used to practice another and materially different process such as a process wherein the molded product is removed by lifting through the top of the mold as opposed to through the bottom of the mold.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a phone conversation with James Larson (Applicant's Representative) on September 9, 2003, the new restriction requirement set forth above was explained. Mr. Larson made a provisional election with traverse to prosecute the invention of Group II, claims 24-44. Affirmation of this election must be made by Applicant in replying to this Office action. Claims 1-23 and 45-61 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 24-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not

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described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The amendment filed August 11, 2003 amends claim 24 to recite "no projection extends into the open bottom of the mold cavity while the flat surface of the pallet is closing the open bottom of the mold cavity." The requirement of "no projection" amounts to a negative limitation. Any negative limitation or exclusionary proviso must have a basis in the original disclosure. Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983). The mere absence of a positive recitation is not basis for an exclusion. See MPEP 2173.05(i). In the instant case, the limitation of no projection is not expressly or implicitly described in the originally filed disclosure, and thus constitutes new matter.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.



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10. Claims 24, 28-32, and 34-35 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 196 34 499 (previously of record, hereinafter "DE '499"; reference below will be made to the drawings of this publication, as well as the English abstract of the publication attached to this action, which is fully supported by the publication).

DE '499 discloses a mold assembly comprising a plurality of side walls (3 and 4) defining a mold cavity (5) with an open top and bottom. The flat surface of a pallet (1), not have any projections, closes the entire bottom of the mold cavity (see figures 1 and 15). The side walls include a converging portion (4) which is movably mounted so that it is movable between a position at an angle with respect to the vertical so that the mold cavity is wider at its top than it is at its bottom, to a position in which the bottom of the mold cavity is wider at the top of the mold cavity (as shown in figure 15). The converging portion (4) defines a substantially vertical, planar surface facing the mold cavity and an undercut adjacent to the bottom of the mold, (see figure 15 and abstract). DE '499 also discloses the assembly to comprise a mechanism (15) for biasing each of the converging side wall portions to the angled position.

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11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that

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was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 25-27, 36-41, and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE '499 in view of Hendrick (U.S. Pat. No. 5,138,616).

DE '499 discloses the mold assembly as described above. DE '499 further discloses the mold assembly to be provided with a stripper shoe (6) for introduction into the mold cavity through the open top of the mold cavity to press the concrete contained in the mold cavity (see figure 15).

DE '499 does not disclose the stripper shoe to comprise a three-dimensional pattern, such as simulating natural stone or a flange, to thereby impart the pattern on the molded concrete product.

Hedrick discloses a mold assembly for making concrete products. The assembly comprises a stripper shoe (74) which is introduced into the top of the mold cavities (see figure 2). The stripper shoe includes three-dimensional patterns (90 and 90a) so that the pattern is imparted on the molded concrete (column 5, lines 43-56).

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It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the mold assembly of DE '499 as such to have made the stripper shoe comprise a three-dimensional pattern because this would allow for the pattern to be imparted on the molded product as suggested by Hedrick.

Claims 26-27 and 37-38 recite specific patterns to be imparted to the brick. Hedrick notes that it is desirable to make custom bricks with different distinctive patterns (column 2, lines 3-7 and lines 30-34). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus of DE '499 as such to have the stripping shoe as such to have distinctive patterns, such as natural stone or flanges at the perimeter, because this would allow for the corresponding distinctive patterns to be imparted to the molded product as desired as suggested by Hedrick.

15. Claim 33 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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16. Claim 42 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not teach or suggest a mold assembly for use in forming masonry blocks comprising a plurality of side walls that are movably mounted and biased with an air bag connected to each of the side walls as recited in the combinations of claims 33 and 42.

The closest prior art taught by DE '499 is described above. DE '499 does not disclose or suggest the use of air bags in the mold assembly arrangement.

18. The following references are cited as being pertinent to the instant application:

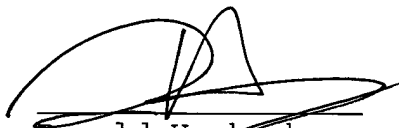
Foxen (U.S. Pat. No. 3,694,128) discloses a block molding apparatus with movable sides (see figure 7).

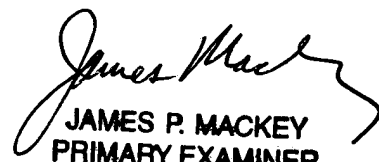
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Ruckstuhl (U.S. Pat. No. 4,869,660) discloses an apparatus for making a concrete block with movable sides (5) that impart a natural pattern (18) on the molded product.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. The unofficial fax phone number is (703) 305-3602.

  
Donald Heckenberg  
September 12, 2003

  
JAMES P. MACKEY  
PRIMARY EXAMINER  
9/15/03